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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/646,430

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Brandon Stuart Burroughs

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EXAMINER

PIZIALI, JEFFREY J

ART UNIT

PAPER NUMBER

2629

MAIL DATE

DELIVERY MODE

02/01/2010

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/646,430

Applicant(s)

BURROUGHS, BRANDON
STUART

Examiner

JEFF PIZIALI

Art Unit

2629

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 1 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 18 November 2009.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-8 and 10-15 is/are pending in the application.
- 4a) Of the above claim(s) 3 and 12 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☐ Claim(s) _____ is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☒ Claim(s) 1,2,4-8,10,11 and 13-15 are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date: _____.
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____.

DETAILED ACTION

Election/Restrictions

1. Restriction to one of the following inventions is required under 35 U.S.C. 121:
 - I.*** *Claims 1, 2, and 4-8*, drawn to a mobile phone subcombination, classified in class 200, subclass 1TK (*i.e., telephone key arrangements*).
 - II.*** *Claims 10, 11, and 13-15*, drawn to a mobile phone combination, classified in class 235, subclass 145 (*i.e., devices having keypads*).

The inventions are distinct, each from the other because of the following reasons:

2. Inventions ***II*** and ***I*** are related respectively as combination and subcombination. Inventions in this relationship are distinct if it can be shown that:
 - (1) the combination as claimed does not require the particulars of the subcombination as claimed for patentability, and
 - (2) that the subcombination has utility by itself or in other combinations (MPEP § 806.05(c)).

(1) In the instant case, the **Combination** (*in claims 10, 11, and 13-15*) as claimed does not require the particulars of the **Subcombination** as claimed (*in claims 1, 2, and 4-8*) because:

The **Combination** as claimed (*in claims 10, 11, and 13-15*) does not require:

"a left set of one or more rows of alphabetical input keys and a right set of one or more rows of alphabetical input keys separated by a centerline," as claimed in independent claim 1 (*lines 5-7*);

"the left set of one or more rows of alphabetical input keys including a top row with a right-most key," as claimed in independent claim 1 (*lines 7-8*);

"the right set of one or more rows of alphabetical input keys including a top row with a left-most key," as claimed in independent claim 1 (*lines 8-9*);

"the right-most key of the top row of the left set of one or more rows of alphabetical input keys being immediately adjacent to the left-most key of the top row of the right set of one or more rows of alphabetical input keys," as claimed in independent claim 1 (*lines 9-12*);

"the left set of one or more rows of alphabetical input keys arranged in one or more respective arcs having one or more respective arc centers located to the left of the centerline," as claimed in independent claim 1 (*lines 13-15*); and

"the right set of one or more rows of alphabetical input keys arranged in one or more respective arcs having one or more respective arc centers located to the right of the centerline," as claimed in independent claim 1 (*lines 15-17*) of the **Subcombination**.

(2) Furthermore, the **Subcombination** has separate utility, such as:

The **Subcombination** as claimed (*in claims 1, 2, and 4-8*) can be used without requiring:

"the alphabetical keypad including a left set of one or more rows of alphabetical input keys including a left-most alphabetical input key and a right most alphabetical input key," as claimed in independent claim 10 (*lines 4-7*);

"a right set of one or more rows of alphabetical input keys including a left-most alphabetical input key and a right most alphabetical input key separated by a centerline," as claimed in independent claim 10 (*lines 7-10*);

"the left set of one or more rows are opposite the right set of one or more rows," as claimed in independent claim 10 (*lines 10-11*); and

"lines drawn through the left-most alphabetical input key and the right most alphabetical input key of the left set of one or more rows of alphabetical input keys and through the right-most alphabetical input key and the left most alphabetical input key of the right set of one or more rows of alphabetical input keys intersect the centerline, immediately adjacent the right-most alphabetical input key of the left set of one or more rows of alphabetical input keys and the left-most alphabetical input key of the right set of one or more rows of alphabetical input keys, to form a V shape with a vertex intersecting the centerline," as claimed in independent claim 10 (*lines 11-19*) of the **Combination**.

The examiner has required restriction between combination and subcombination inventions.

Where applicant elects a subcombination, and claims thereto are subsequently found allowable, any claim(s) depending from or otherwise requiring all the limitations of the allowable subcombination will be examined for patentability in accordance with 37 CFR 1.104. See MPEP § 821.04(a).

Applicant is advised that if any claim presented in a continuation or divisional application is anticipated by, or includes all the limitations of, a claim that is allowable in the present application, such claim may be subject to provisional statutory and/or nonstatutory double patenting rejections over the claims of the instant application.

3. Restriction for examination purposes as indicated is proper because all these inventions listed in this action are independent or distinct for the reasons given above and there would be a serious search and examination burden if restriction were not required because one or more of the following reasons apply:

- (a) the inventions have acquired a separate status in the art in view of their different classification;
- (b) the inventions have acquired a separate status in the art due to their recognized divergent subject matter;
- (c) the inventions require a different field of search (for example, searching different classes/subclasses or electronic resources, or employing different search queries);

(d) the prior art applicable to one invention would not likely be applicable to another invention;

(e) the inventions are likely to raise different non-prior art issues under 35 U.S.C. 101 and/or 35 U.S.C. 112, first paragraph.

Applicant is advised that the reply to this requirement to be complete must include

(i) an election of a invention to be examined even though the requirement may be traversed (37 CFR 1.143) **and (ii) identification of the claims encompassing the elected invention.**

The election of an invention may be made with or without traverse. To reserve a right to petition, the election must be made with traverse. If the reply does not distinctly and specifically point out supposed errors in the restriction requirement, the election shall be treated as an election without traverse. Traversal must be presented at the time of election in order to be considered timely. Failure to timely traverse the requirement will result in the loss of right to petition under 37 CFR 1.144. If claims are added after the election, applicant must indicate which of these claims are readable on the elected invention.

If claims are added after the election, applicant must indicate which of these claims are readable upon the elected invention.

Should applicant traverse on the ground that the inventions are not patentably distinct, applicant should submit evidence or identify such evidence now of record showing the inventions to be obvious variants or clearly admit on the record that this is the case. In either instance, if the examiner finds one of the inventions unpatentable over the prior art, the evidence or admission may be used in a rejection under 35 U.S.C. 103(a) of the other invention.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jeff Piziali whose telephone number is (571) 272-7678. The examiner can normally be reached on Monday - Friday (6:30AM - 3PM).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Chanh Nguyen can be reached on (571) 272-7772. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Jeff Piziali/
Primary Examiner, Art Unit 2629
26 January 2010